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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,750	09/28/2001	Joseph L. Gargiulo	F-350	2978

919 7590 03/24/2005

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/965,750

Applicant(s)

GARGIULO, JOSEPH L.

Examiner

Edward R. Cosimano

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.

2. The use of various trademark(s), for example: "Personal Post™", "Galaxy®", "DM300™", have been noted in this application at paragraph located:

A) at page 7, lines 5-20, "Referring to Fig. 1, a representative example ... architecture, such as the Personal Post™ meter, the Galaxy® mailing machine, the DM300™ digital mail processor, all ... which facilitates an understanding of the present invention.";

Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data first paragraph on page1 as amended May 12, 2004, "This application is related to commonly assigned, co-pending U.S. Patent Application Serial No.: 09/965,753, filed on even date herewith, entitled "POSTAGE METERING SYSTEM HAVING TELEPHONE ANSWERING CAPABILITY," in the name of Joseph L. Garagiulo.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

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5. Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In regard to claims 1-18, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claims 1, 8 & 15, and how either the "control system" of claim 1 or the method of claims 8 & 15 may perform the functions of receiving and storing voice messages from telephone calls directed to one of the population of postage meters, since the invention as recited in these claims does not require that the postage metering system in the "population of postage metering systems be connected to the telephone system so that a postage meter could receive a telephone call and a message that would be stored in the control system for payback from a different postage metering system.

B) in regard to claims 1, 2, 8, 9, 15 & 16, and how the "control system" of claims 1-2 or the methods of claims 8-9 & 15-16 can retrieve and print the voice messages stored at one postage meter system from another postage meter system, since the invention as recited in these claims has not received, entered, or obtained an indication of from which postage meter system the message is to be retrieved or to which postage meter system the retrieved message is to be sent to, since the invention recites a population of postage meters all of which may have different operators to whom the messages are directed.

C) in regard to claims 3-4, 10-11 & 17-18, and how the recited system/method may use "a previously established parsing parameter set by an operator", since the invention as recited in these claims has not received, entered, or obtained either the

“previously established parsing parameter” or an indication of which “previously established parsing parameter” is to be used to parse the message as recited in this function, since the invention recites a population of postage meters all of which may have different operators and hence different “previously established parsing parameters”.

D) in regard to claims 5-7 & 12-14, and how the either the “control system” of claims 5-7 or the method of claims 12-14 may receive, store and upload voice messages and/or “computer based text” from one or more of the postage metering systems using a “previously established upload preference data”, whether the data is store at the meter or the control system, since:

(1) the invention as recited in claims 5 & 12 does not receive “computer based text” nor require that the postage metering system in the “population of postage metering systems be connected to the telephone system so that a postage meter could store either voice messages or “computer based text” which may be uploaded to the “control system”; or

(2) the invention as recited in claims 5-7 & 12-14;

(a) has not received, entered, or obtained either the “previously established upload preference data” or an indication of which “previously established upload preference data” is to be used to upload the message as recited in this function, since the invention recites a population of postage meters all of which may have different operators and hence different “previously established parsing parameters”; and

(b) does not require that the postage metering system in the “population of postage metering systems be connected to the telephone system so that a postage meter could store either voice messages or “computer based text” which may be uploaded to the “control system”.

5.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

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6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6.1 Claims 1-18 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

6.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

6.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

6.1.3 As can be seen from claims 1-18, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 1-18 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

7. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

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A) in regard to claims 1, 8 & 15, the prior art does not teach or suggest a system/method in which a postage meter is modified to provide the non postage related function of an answering machine. Claims 2-7, 9-14 & 16-18 are allowable for the same reason.

8. The examiner has cited prior art of interest, for example:

A) Le Carpentier (4,752,950) which discloses a population of postage meters connected to a series of location stations which in turn are connected to a central location that collects and stores information about the operation of each postage meter in the population of postage meters.

B) Chamberlin et al (4,817,127) which discloses a dictation system that operates like an remote answering machine and in which messages may be transcribed.

C) Hashimoto (4,821,311) which discloses a telephone answering machine that will answer incoming calls, digitally record messages and then under either remote or local control play back the recorded messages.

D) Otsuki (5,311,573) disclose a facsimile machine controller that will provide the additional function of an answering machine.

E) Schwartz et al (5,615,120) which discloses the user of voice recognition systems in postage metering systems for entering commands in to the postage metering system.

F) Choi (WO 00/28719) which discloses a internet based answering system in which digitally recorded messages are transcribed into e-mails which are then sent via the internet to the user.

G) Katikaneni et al (6,356,883) which discloses that postage metering systems may print various messages along with the postage indicia on items of mail.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through



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Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/17/05

  
Edward R. Cosimano  
Primary Examiner A.U. 3629